

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)	
)	Mail Stop APPEAL BRIEF - PATENTS
Richard S. BICE et al.)	
)	
Application No.: 09/879,816)	Group Art Unit: 2143
)	
Filed: June 12, 2001)	Examiner: J. Avellino
)	
For: AUTOMATED MESSAGE)	
HANDLING SYSTEM AND)	
PROCESS)	

U.S. Patent and Trademark Office
Customer Window, Mail Stop **Appeal Brief - Patents**
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Alexandria, Virginia 22314

APPEAL BRIEF

This Appeal Brief is submitted in response to the non-final Office Action, dated December 14, 2005, which re-opened prosecution of the present application, and in support of the Notice of Appeal, filed March 1, 2006.

I. **REAL PARTY IN INTEREST**

The real party in interest in this appeal is MCI, LLC., affiliate of Verizon Communications, Inc.

II. RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS

Appellants are unaware of any related appeals, interferences or judicial proceedings.

III. STATUS OF CLAIMS

Claims 2-9, 14-20, 24-31, and 34-36 are pending in this application.

Claims 2-9, 14-20, 24-31, and 34-36 were rejected in the Office Action, dated December 14, 2005, and are the subject of the present appeal. These claims are reproduced in the Claim Appendix of this Appeal Brief.

IV. STATUS OF AMENDMENTS

No amendment was filed subsequent to the Office Action, dated December 14, 2005, which re-opened prosecution of this application.

V. SUMMARY OF CLAIMED SUBJECT MATTER

In the paragraphs that follow, each of the independent claims that is involved in this appeal and each dependent claim that is argued separately will be recited followed in parenthesis by examples of where support can be found in the specification and drawings.

Claim 2 recites that the at least one customer-defined message handling rule directs notification of a third party software developer when a software fault is indicated by the contents of a message (e.g., pg. 18, lines 3-11).

Claim 8 recites that the portal interface allows a customer to express without prompting at least one desired recipient (e.g., Fig. 5; pg 20, lines 5-7).

Claim 9 recites a contacts list tool, said contacts list tool identifying entities associated with a hosted application, wherein said portal interface further identifies entities associated with a hosted application by reference to the contacts list tool, and presents the entities associated with a hosted application to a customer as potential recipients of an automatically forwarded message (e.g., 130, Fig. 1; pg. 18, line 12, to pg. 19, line 4).

Claim 17 recites displaying a list of available delivery methods for automatic forwarding of messages to a customer, and determining from the customer a desired delivery method for transmission of a message to a desired recipient, wherein at least one delivery method comprises transmission to a pager (e.g., Figs. 5 and 6).

Claim 18 recites displaying a list of available delivery methods for automatic forwarding of messages to a customer, and determining from the customer a desired delivery method for transmission of a message to a desired recipient, wherein at least one delivery method comprises e-mail transmission (e.g., Figs. 5 and 6).

Claim 19 recites displaying a list of available delivery methods for automatic forwarding of messages to a customer, and determining from the customer a desired delivery method for transmission of a message to a desired recipient, wherein at least one delivery method comprises transmission via an Internet post (e.g., Figs. 5 and 6).

Claim 20 recites determining a list of entities associated with a hosted application to which the at least one customer-defined message handling rule is applicable by reference to a contacts list tool and displaying the list of entities associated with the hosted application to which the at least one customer-defined message handling rule is applicable to the customer to assist a customer in determining desired recipients of forwarded messages (e.g., pg. 19, line 18, to pg. 20,

line 12).

Claim 31 recites determine a list of potential recipients to whom a software fault message may be automatically forwarded by reference to data stored in a contacts list management tool, and cause the determined list to be displayed to a customer to assist the customer in identifying recipients to whom a software fault message should automatically be forwarded (e.g., pg. 19, line 18, to pg. 20, line 12).

Claim 34 recites a network-based automated message handling system for initiating responses to messages transmitted through a network by application components, the system comprising at least one customer-defined message handling rule (e.g., pg. 18, lines 3-11); at least one service-based message handling rule (e.g., pg. 29, lines 8-14); at least one common message handling rule (e.g., pg. 28, lines 10-19); and a message handler (e.g., 104, Fig. 1; pg. 11, lines 4-20) configured to receive a message from an application component (e.g., pg. 34, lines 3-5), determine, based on a content of the received message, whether to apply the at least one customer-defined message handling rule (e.g., pg. 34, lines 3-5), determine, based on the content of the received message, whether to apply the at least one service-based message handling rule (e.g., pg. 34, lines 3-5), determine, based on the content of the received message, whether to apply the at least one common message handling rule (e.g., pg. 34, lines 3-5), identify at least one first party when the at least one customer-defined message handling rule applies to the received message (e.g., pg. 35, lines 5-7, and pg. 17, line 15, to pg. 19, line 17), identify at least one second party when the at least one service-based message handling rule applies to the received message (e.g., pg. 35, lines 7-9), identify at least one third party when the at least one common message handling rule applies to the received message (e.g., pg. 35, lines 7-9), and generate new

messages to the identified at least one first party, the identified at least one second party, and the identified at least one third party (e.g., pg. 35, lines 5-9).

Claim 35 recites a process for automated dissemination of application component information, the process comprising receiving an information message from an application component (e.g., pg. 34, lines 3-5); determining, based on a content of the information message, whether to apply at least one customer-defined message handling rule to the received information message (e.g., pg. 34, lines 3-5); determining, based on the content of the information message, whether to apply at least one service-based message handling rule to the received information message (e.g., pg. 34, lines 3-5); determining, based on the content of the information message, whether to apply at least one common message handling rule to the received information message (e.g., pg. 34, lines 3-5); identifying a first group of parties when the at least one customer-defined message handling rule applies to the received information message (e.g., pg. 35, lines 5-7, and pg. 17, line 15, to pg. 19, line 17); identifying a second group of parties when the at least one service-based message handling rule applies to the received information message (e.g., pg. 35, lines 7-9); identifying a third group of parties when the at least one common message handling rule applies to the received information message (e.g., pg. 35, lines 7-9); and generating new messages to the identified first group of parties, the identified second group of parties, and the identified third group of parties (e.g., pg. 35, lines 5-9).

Claim 36 recites a computer-readable medium tangibly embodying instructions which, when executed by a computer, implement a process for automating message handling, the instructions causing a message handler to receive a message (e.g., pg. 34, lines 3-5); determine, based on a content of the message, whether to apply at least one customer-defined message

handling rule, at least one service-based message handling rule, or at least one common message handling rule to the received message (e.g., pg. 34, lines 3-5); identify a first group of parties when the at least one customer-defined message handling rule applies to the received message (e.g., pg. 35, lines 5-7, and pg. 17, line 15, to pg. 19, line 17); identify a second group of parties when the at least one service-based message handling rule applies to the received message (e.g., pg. 35, lines 7-9); identify a third group of parties when the at least one common message handling rule applies to the received message (e.g., pg. 35, lines 7-9); and generate new messages to the identified first group of parties, the identified second group of parties, and the identified third group of parties (e.g., pg. 35, lines 5-9).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

A. Claims 3-8, 14, 15, 24-28, and 34-36 stand rejected under 35 U.S.C. § 102(e) as anticipated by Brown et al. (U.S. Patent No. 6,631,363).

B. Claims 2, 16, and 29-31 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Brown et al. (U.S. Patent No. 6,631,363) in view of Teegan et al. (U.S. Patent No. 6,748,555).

C. Claims 9 and 20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Brown et al. (U.S. Patent No. 6,631,363) in view of Escobar (U.S. Patent No. 5,926,100).

D. Claims 17-19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Brown et al. (U.S. Patent No. 6,631,363).

VII. ARGUMENTS**A. The rejection under 35 U.S.C. § 102(e) based on Brown et al. (U.S. Patent No. 6,631,363) should be reversed.**

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention always rests upon the Examiner. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). A proper rejection under 35 U.S.C. § 102 requires that a single reference teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987).

1. Claims 3-7, 14, 15, 34, and 35.

Independent claim 34 is directed to a network-based automated message handling system for initiating responses to messages transmitted through a network by application components. The system includes at least one customer-defined message handling rule, at least one service-based message handling rule, at least one common message handling rule, and a message handler. The message handler is configured to receive a message from an application component, determine, based on a content of the received message, whether to apply the at least one customer-defined message handling rule, determine, based on the content of the received message, whether to apply the at least one service-based message handling rule, determine, based on the content of the received message, whether to apply the at least one common message handling rule, identify at least one first party when the at least one customer-defined message handling rule applies to the received message, identify at least one second party when the at least one service-based message handling rule applies to the received message, identify at least one third party when the at least one common message handling rule applies to the received message,

and generate new messages to the identified at least one first party, the identified at least one second party, and the identified at least one third party. Brown et al. does not disclose or suggest this combination of features.

For example, Brown et al. does not disclose or suggest at least one customer-defined message handling rule, at least one service-based message handling rule, and at least one common message handling rule. The Examiner relies on col. 3, lines 43-60, of Brown et al. for allegedly disclosing at least one service-based message handling rule and on col. 5, lines 20-25, of Brown et al. for allegedly disclosing at least one common message handling rule (Office Action, pg. 3). Appellants submit that these sections of Brown et al. do not disclose or suggest at least one service-based message handling rule or at least one common message handling rule, as recited in claim 34.

At col. 3, lines 43-60, Brown et al. discloses:

A second kind of application that can generate events is referred to herein generally as "batch jobs." These jobs are applications that, generally, periodically check persistent data, such as data stored in a database, and look for changes that may have occurred. For example, if an application which enters new products into a database is not one which has previously been coded as a business object, to generate explicit events on this occurrence, a batch job 34 can periodically scan a product database and determine when new products have been added. Events which are discovered by such a comparison between a previous state of an object, in a persistent memory, with the current state are referred to herein as "implicit events."

Use of batch jobs to scan data looking for implicit events is useful both for events which occur over time, and for use with applications which are not already coded to generate the desired explicit events.

This section of Brown et al. discloses the use of batch jobs to scan data looking for implicit events, which are defined as events that are discovered by a comparison between a previous state

of an object and a current state of the object. This section of Brown et al. does not disclose or suggest at least one service-based message handling rule, as recited in claim 34. Instead, Brown et al. merely discloses that alert manager 24 uses a set of rules to determine to whom, and when, a notification is to be made to a user. Brown et al. does not disclose or suggest the three separate types of rules - at least one customer-defined message handling rule, at least one service-based message handling rule, and at least one common message handling rule recited in claim 34.

At col. 5, lines 20-25, Brown et al. discloses:

Rules portions 60 contains a large number of rules defining when events are to be acted upon. Each user who desires to receive alert notifications from alert manager 24 will register with the alert manager, and define the conditions under which that user wishes to receive a notification. Rules are generally conditional statements which define where the notification is to be generated.

This section of Brown et al. discloses that a user may define conditions under which that user wishes to receive a notification. This section of Brown et al. in no way discloses or suggests at least one common message handling rule, as recited in claim 34. The rules disclosed in this section of Brown et al. are user-defined and not common message handling rules. The Examiner does not explain how these user-defined rules can reasonably be interpreted as common message handling rules.

Further with respect to the above features of claim 34, the Examiner attempts to define customer-defined message handling rules, service-based rules, and common message handling rules on page 9 of the Office Action. More thorough definitions and examples of each of these different types of message handling rules can be found on pages 17-31 of Appellants' specification.

The Examiner alleges that "[f]irst, it should be noted that Applicant does not disclose that

each of the message handling rules must be exclusive (i.e. the customer-defined rules must be exclusive of the service-based rules, which must be exclusive to the common rules)" (Office Action, pg. 9). The Examiner further alleges that since the user in Brown et al. must register with the system, any and all rules defined by the user are inherently service-based rules since any rules are dependent upon the service subscribed to by the user (Office Action, pg. 9). Appellants respectfully disagree with the Examiner's allegations.

Claim 34 specifically recites three different types of message handling rules – customer-defined, service-based, and common. Claim 34 also specifically recites a message handler configured to perform acts based on each of these different types of message handling rules. The Examiner's allegation that these different types of message handling rules can be construed as a single type of message handling rule is flawed. For example, the customer-defined message handling rules, as the name suggests, include rules defined by the customer. The service-based message handling rules, on the other hand, include rules provided by a service provider (see, for example, pg. 30, lines 3-4, of Appellants' specification). Thus, contrary to the Examiner's allegation, customer-defined message handling rules and service-based message handling rules are different types of rules. The Examiner's attempt at reconstructing Appellants' claimed features by alleging that the different features are equivalent to a single feature is clearly impermissible and not supported by the actual language recited in claim 34.

The Examiner also alleges that "Brown's common-message handling rules can be found in the alert manager, since the alert manager is applicable to all customers" (Office Action, pg. 9). Appellants respectfully disagree with the Examiner's interpretation of Brown et al.

Brown et al. describes the operation of alert manager 24 with respect to Fig. 5. Brown et

al. discloses that an alert manager 24 includes a rules portion 60 containing a large number of rules defining when events are to be acted upon (col. 5, lines 19-22). Brown et al. discloses that each user who desires to receive alert notifications from alert manager 24 will register with the alert manager, and define the conditions under which that user wishes to receive a notification (col. 5, lines 22-27). Clearly, the rules in the Brown et al. system are user-defined rules. Contrary to the Examiner's allegation, nowhere does Brown et al. disclose or suggest at least one common message handling rule, as is recited in claim 34, in addition to at least one customer-defined (or user-defined) message handling rule.

Claim 34, as discussed above, recites three different types of message handling rules – customer-defined message handling rules, service-based message handling rules, and common message handling rules. The Examiner has not pointed to any section of Brown et al. that discloses the recited types of message handling rules.

Since Brown et al. does not disclose or suggest at least one customer-defined message handling rule, at least one service-based message handling rule, and at least one common message handling rule, Brown et al. cannot disclose or suggest a message handler configured to determine, based on a content of a received message, whether to apply the at least one customer-defined message handling rule, determine, based on the content of the received message, whether to apply the at least one service-based message handling rule, determine, based on the content of the received message, whether to apply the at least one common message handling rule, identify at least one first party when the at least one customer-defined message handling rule applies to the received message, identify at least one second party when the at least one service-based message handling rule applies to the received message, identify at least one third party when the

at least one common message handling rule applies to the received message, and generate new messages to the identified at least one first party, the identified at least one second party, and the identified at least one third party, as also recited in claim 34. Instead, Brown et al. merely discloses an event router 16 that receives incoming events and routes them to recipients that have registered to receive events of this type (col. 2, lines 61-64). Brown et al. does not disclose or suggest that event router 16 determines, based on a content of a received message, whether at least one customer-defined message handling rule, at least one service-based message handling rule, and at least one common message handling rule apply to the message, and identifies at least one first party when the at least one customer-defined message handling rule applies to the received message, identifies at least one second party when the at least one service-based message handling rule applies to the received message, and identifies at least one third party when the at least one common message handling rule applies to the received message, as recited in claim 34.

For at least the foregoing reasons, Appellants submit that the rejection of claim 34 under 35 U.S.C. § 102(e) based on Brown et al. is improper. Accordingly, Appellants request that the rejection be reversed.

Claims 3-7, 14, 15, and 35 stand or fall with the rejection of claim 34. Therefore, Appellants submit that the rejection of claims 3-7, 14, 15, and 35 under 35 U.S.C. § 102(e) based on Brown et al. is improper for at least the reasons given above with respect to claim 34. Accordingly, Appellants request that the rejection of these claims be reversed.

2. Claim 8.

Claim 8 depends from claim 34. Therefore, claim 8 is not anticipated by Brown et al. for

at least the reasons given above with respect to claim 34. Moreover, claim 8 recites additional features not disclosed or suggested by Brown et al.

Claim 8 recites that the portal interface allows a customer to express without prompting at least one desired recipient. The Examiner alleges that "the user is considered the recipient of the message" and points to col. 5, lines 18-27, of Brown et al. for support. Appellants submit that this section of Brown et al. in no way discloses or suggests a portal interface that allows a customer to express without prompting at least one desired recipient.

At col. 5, lines 18-27, Brown et al. discloses:

Within alert manager 24 are two major portions. These include a rules portion 60, and a notifications portion 62. Rules portions 60 contains a large number of rules defining when events are to be acted upon. Each user who desires to receive alert notifications from alert manager 24 will register with the alert manager, and define the conditions under which that user wishes to receive a notification. Rules are generally conditional statements which define where the notification is to be generated.

This section of Brown et al. discloses that users may register with alert manager and define conditions under which that user wishes to receive notifications. This section of Brown et al. in no way discloses or suggests a portal interface that allows a customer to express without prompting at least one desired recipient, as recited in claim 8. The Examiner has not pointed to any section of Brown et al. that discloses that the user can express a desired recipient. Instead, it seems that the desired recipient seems to only include the user himself/herself. Therefore, there would be no need for the user to express a recipient in Brown et al.

These arguments were presented in the Appeal Brief, filed October 17, 2005. Appellants note that the outstanding Office Action, which re-opened prosecution, does not address these arguments.

For at least these additional reasons, Appellants submit that the rejection of claim 8 under 35 U.S.C. § 102(e) based on Brown et al. is improper. Accordingly, Appellants request that the rejection be reversed.

3. Claims 24-28 and 36.

Independent claim 36 is directed to a computer-readable medium tangibly embodying instructions which, when executed by a computer, implement a process for automating message handling. The instructions cause a message handler to receive a message; determine, based on a content of the message, whether to apply at least one customer-defined message handling rule, at least one service-based message handling rule, or at least one common message handling rule to the received message; identify a first group of parties when the at least one customer-defined message handling rule applies to the received message; identify a second group of parties when the at least one service-based message handling rule applies to the received message; identify a third group of parties when the at least one common message handling rule applies to the received message; and generate new messages to the identified first group of parties, the identified second group of parties, and the identified third group of parties. Brown et al. does not disclose or suggest this combination of features.

For example, Brown et al. does not disclose or suggest a message handler determining, based on a content of a received message, whether to apply at least one customer-defined message handling rule, at least one service-based message handling rule, or at least one common message handling rule to the received message. The Examiner does not specifically address the features of claim 36 in the Office Action, but rather relies on the rejection of claims 3-8, 10-12, and 34 (Office Action, pg. 5). With respect to claim 34, the Examiner relies on col. 3, lines 43-

60, of Brown et al. for allegedly disclosing at least one service-based message handling rule and on col. 5, lines 20-25, of Brown et al. for allegedly disclosing at least one common message handling rule (Office Action, pg. 3). Appellants submit that these sections of Brown et al. do not disclose or suggest a message handler determining, based on a content of a received message, whether to apply at least one customer-defined message handling rule, at least one service-based message handling rule, or at least one common message handling rule to the received message, as recited in claim 36.

At col. 3, lines 43-60, Brown et al. discloses:

A second kind of application that can generate events is referred to herein generally as "batch jobs." These jobs are applications that, generally, periodically check persistent data, such as data stored in a database, and look for changes that may have occurred. For example, if an application which enters new products into a database is not one which has previously been coded as a business object, to generate explicit events on this occurrence, a batch job 34 can periodically scan a product database and determine when new products have been added. Events which are discovered by such a comparison between a previous state of an object, in a persistent memory, with the current state are referred to herein as "implicit events."

Use of batch jobs to scan data looking for implicit events is useful both for events which occur over time, and for use with applications which are not already coded to generate the desired explicit events.

This section of Brown et al. discloses the use of batch jobs to scan data looking for implicit events, which are defined as events that are discovered by a comparison between a previous state of an object and a current state of the object. This section of Brown et al. does not disclose or suggest at least one service-based message handling rule, as recited in claim 36. Instead, Brown et al. merely discloses that alert manager 24 uses a set of rules to identify those users that have registered to receive notifications. Brown et al. does not disclose or suggest the three types of

rules - at least one customer-defined message handling rule, at least one service-based message handling rule, and at least one common message handling rule recited in claim 36, for reasons similar to the reasons given above with respect to claim 34. Therefore, Brown et al. cannot disclose or suggest a message handler determining, based on a content of a received message, whether to apply at least one customer-defined message handling rule, at least one service-based message handling rule, or at least one common message handling rule to the received message, as recited in claim 36.

At col. 5, lines 20-25, Brown et al. discloses:

Rules portions 60 contains a large number of rules defining when events are to be acted upon. Each user who desires to receive alert notifications from alert manager 24 will register with the alert manager, and define the conditions under which that user wishes to receive a notification. Rules are generally conditional statements which define where the notification is to be generated.

This section of Brown et al. discloses that a user may define conditions under which that user wishes to receive a notification. This section of Brown et al. in no way discloses or suggests at least one common message handling rule, as recited in claim 36. The rules disclosed in this section of Brown et al. are user-defined and not common message handling rules. The Examiner does not explain how these user-defined rules can reasonably be interpreted as common message handling rules. This section of Brown et al. in no way discloses or suggests a message handler determining, based on a content of a received message, whether to apply at least one customer-defined message handling rule, at least one service-based message handling rule, or at least one common message handling rule to the received message, as recited in claim 36.

Since Brown et al. does not disclose or suggest a message handler determining, based on a content of a received message, whether to apply at least one customer-defined message

handling rule, at least one service-based message handling rule, or at least one common message handling rule to the received message, Brown et al. cannot disclose or suggest a message handler to identify a first group of parties when the at least one customer-defined message handling rule applies to the received message, identify a second group of parties when the at least one service-based message handling rule applies to the received message, identify a third group of parties when the at least one common message handling rule applies to the received message, and generate new messages to the identified first group of parties, the identified second group of parties, and the identified third group of parties, as also recited in claim 36. Instead, Brown et al. merely discloses an event router 16 that receives incoming events and routes them to recipients that have registered to receive events of this type (col. 2, lines 61-64). Brown et al. does not disclose or suggest that event router 16 identifies a first group of parties when the at least one customer-defined message handling rule applies to the received message, identifies a second group of parties when the at least one service-based message handling rule applies to the received message, identifies a third group of parties when the at least one common message handling rule applies to the received message, and generates new messages to the identified first group of parties, the identified second group of parties, and the identified third group of parties, as recited in claim 36.

For at least the foregoing reasons, Appellants submit that the rejection of claim 36 under 35 U.S.C. § 102(e) based on Brown et al. is improper. Accordingly, Appellants request that the rejection be reversed.

Claims 24-28 stand or fall with the rejection of claim 36. Therefore, Appellants submit that the rejection of claims 24-28 under 35 U.S.C. § 102(e) based on Brown et al. is improper for

at least the reasons given above with respect to claim 36. Accordingly, Appellants request that the rejection of these claims be reversed.

B. The rejection under 35 U.S.C. § 103(a) based on Brown et al. (U.S. Patent No. 6,631,363) in view of Teegan et al. (U.S. Patent No. 6,748,555) should be reversed.

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention always rests upon the Examiner. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In rejecting a claim under 35 U.S.C. § 103, the Examiner must provide a factual basis to support the conclusion of obviousness. In re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). Based upon the objective evidence of record, the Examiner is required to make the factual inquiries mandated by Graham v. John Deere Co., 86 S.Ct. 684, 383 U.S. 1, 148 USPQ 459 (1966). The Examiner is also required to explain how and why one having ordinary skill in the art would have been realistically motivated to modify an applied reference and/or combine applied references to arrive at the claimed invention. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

In establishing the requisite motivation, it has been consistently held that the requisite motivation to support the conclusion of obviousness is not an abstract concept, but must stem from the prior art as a whole to impel one having ordinary skill in the art to modify a reference or to combine references with a reasonable expectation of successfully achieving some particular realistic objective. See, for example, Interconnect Planning Corp. v. Feil, 227 USPQ 543 (Fed. Cir. 1985). Consistent legal precedent admonishes against the indiscriminate combination of prior art references. Carella v. Starlight Archery, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986);

Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985).

1. Claims 2 and 16.

Claim 2 depends from claim 34. The disclosure of Teegan et al. does not remedy the deficiencies in the disclosure of Brown et al. set forth above with respect to claim 34. Therefore, claim 2 is patentable over Brown et al. and Teegan et al., whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 34. Moreover, claim 2 recites an additional feature that is not disclosed or suggested by Brown et al. and Teegan et al.

Claim 2 recites that the at least one customer-defined message handling rule directs notification of a third party software developer when a software fault is indicated by the contents of a message. The Examiner admits that Brown et al. does not disclose this feature and relies on col. 16, lines 6-14, of Teegan et al. for allegedly disclosing the feature of claim 2 (Office Action, pg. 7). Appellants respectfully disagree with the Examiner's interpretation of Teegan et al.

At col. 16, lines 6-14, Teegan et al. discloses:

Finally, the software manager can be configured to generate a variety of alerts when program-level operational management metrics go outside specified thresholds or if a particular event is received. Alerts can take various forms, such as changing a screen condition (e.g., highlighting an icon representing a program or server), sending an email, or paging an administrator. Alerts can also be used to communicate from one software manager to another, as described in more detail below.

This section of Teegan et al. discloses that an alert can be sent from one software manager to another. This section of Teegan et al. in no way relates to at least one customer-defined message handling rule that directs notification of a third party software developer when a software fault is

indicated by the contents of a message, as recited in claim 2.

Even assuming, for the sake of argument, that the above section of Teegan et al. could reasonably be construed to disclose the feature of claim 2 (a point that Appellants do not concede), Appellants submit that one skilled in the art at the time of Appellants' invention would not have been motivated to incorporate this alleged teaching of Teegan et al. into the Brown et al. system, absent impermissible hindsight. With respect to motivation, the Examiner alleges "[i]t would be obvious ... to combine the teaching of Teegan with Brown since Brown discloses that the event notification system can 'also work with applications which do not generate such events, and is adaptable to nearly any type of computer application' (col. 2, lines 35-38). This would lead one of ordinary skill in the art to search analogous art which would yield the system disclosed in Teegan. By this rationale, it would be obvious to combine these references" (final Office Action, pg. 6). Appellants respectfully disagree.

At the outset, Appellants note that the Examiner's motivation seems to be directed to how one skilled in the art would come across the Teegan et al. document. The Examiner's motivation does not, however, explain why one skilled in the art would seek to combine Teegan et al.'s alleged teaching of at least one customer-defined message handling rule that directs notification of a third party software developer when a software fault is indicated by the contents of a message into the Brown et al. system, as is required for establishing a *prima facie* case of obviousness. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 2.

Moreover, Appellants note that, as set forth above with respect to claim 34, Brown et al. discloses that a customer may define the notifications that that customer wishes to receive (col. 5,

lines 7-9). Brown et al. does not disclose or suggest that a customer can define notifications for receipt by another party. The Examiner does not explain why one skilled in the art would seek to modify the Brown et al. system to include this capability. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 2.

For at least these additional reasons, Appellants submit that the rejection of claims 2 and 16 under 35 U.S.C. § 103(a) based on Brown et al. and Teegan et al. is improper. Accordingly, Appellants request that the rejection be reversed.

2. Claim 29.

Claim 29 depends from claim 36. The disclosure of Teegan et al. does not remedy the deficiencies in the disclosure of Brown et al. set forth above with respect to claim 36. Therefore, claim 29 is patentable over Brown et al. and Teegan et al., whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 36.

3. Claim 30.

Claim 30 depends from claim 29. Therefore, claim 30 is patentable over Brown et al. and Teegan et al., whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 29. Moreover, claim 30 recites a feature similar to a feature described above with respect to claim 2. Therefore, claim 30 is further patentable over Brown et al. and Teegan et al. for at least reasons similar to reasons given above with respect to claim 2.

4. Claim 31.

Claim 31 depends from claim 30. Therefore, claim 31 is patentable over Brown et al. and Teegan et al., whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 30. Moreover, claim 31 recites additional features not

disclosed or suggested by Brown et al. and Teegan et al.

Claim 31 recites that the message handler is further configured to determine a list of potential recipients to whom a software fault message may be automatically forwarded by reference to data stored in a contacts list management tool, and cause the determined list to be displayed to a customer to assist the customer in identifying recipients to whom a software fault message should automatically be forwarded. The Examiner does not address these features in the Office Action. Instead, the Examiner relies on the rejection of claim 2 for addressing the above features of claim 31 (Office Action, pg. 7). Appellants' claim 2, however, does not recite the above features of claim 31. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 31.

Nonetheless, Brown et al. and Teegan et al., whether taken alone or in any reasonable combination, do not disclose or suggest a message handler that is configured to determine a list of potential recipients to whom a software fault message may be automatically forwarded by reference to data stored in a contacts list management tool, and cause the determined list to be displayed to a customer to assist the customer in identifying recipients to whom a software fault message should automatically be forwarded, as recited in claim 31.

For at least these additional reasons, Appellants submit that the rejection of claim 31 under 35 U.S.C. § 103(a) based on Brown et al. and Teegan et al. is improper. Accordingly, Appellants request that the rejection be reversed.

C. The rejection under 35 U.S.C. § 103(a) based on Brown et al. (U.S. Patent No. 6,631,363) in view of Escolar (U.S. Patent No. 5,926,100) should be reversed.

1. Claim 9.

Claim 9 depends from claim 4. The disclosure of Escolar does not remedy the deficiencies in the disclosure of Brown et al. set forth above with respect to claim 4. Therefore, claim 9 is patentable over Brown et al. and Escolar, whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 4. Moreover, claim 9 recites other features not disclosed or suggested by Brown et al. and Escolar.

Claim 9 recites a contacts list tool, the contacts list tool identifying entities associated with a hosted application, wherein the portal interface further identifies entities associated with a hosted application by reference to the contacts list tool, and presents the entities associated with a hosted application to a customer as potential recipients of an automatically forwarded message. Brown et al. and Escolar do not disclose or suggest this combination of features.

For example, Brown et al. and Escolar do not disclose or suggest a portal interface that presents entities identified by a contacts list tool associated with a hosted application to a customer as potential recipients of an automatically forwarded message. The Examiner admits that Brown et al. does not disclose this feature and relies on element 48 of Escolar's Fig. 3 as allegedly disclosing this feature (Office Action, pg. 8). Appellants respectfully disagree with the Examiner's interpretation of Escolar.

Element 48 in Escolar's Fig. 3 corresponds to a list of contact numbers to call in response to an alarm (col. 3, lines 11-20). Escolar in no way discloses or suggests that list 48 is presented to a customer as potential recipients of an automatically forwarded message, as recited in claim 9. In stark contrast, list 48 provides the order in which telephone calls are to be placed in response to an alarm.

For at least these additional reasons, Appellants submit that the rejection of claim 9 under

35 U.S.C. § 103(a) based on Brown et al. and Escolar is improper. Accordingly, Appellants request that the rejection be reversed.

2. Claim 20.

Claim 20 depends from claim 35. The disclosure of Escolar does not remedy the deficiencies in the disclosure of Brown et al. set forth above with respect to claim 35. Therefore, claim 20 is patentable over Brown et al. and Escolar, whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 35. Moreover, claim 20 recites other features not disclosed or suggested by Brown et al. and Escolar.

Claim 20 recites determining a list of entities associated with a hosted application to which the at least one customer-defined message handling rule is applicable by reference to a contacts list tool and displaying the list of entities associated with the hosted application to which the at least one customer-defined message handling rule is applicable to the customer to assist a customer in determining desired recipients of forwarded messages. Brown et al. and Escolar do not disclose or suggest this combination of features.

For example, Brown et al. and Escolar do not disclose or suggest displaying the list of entities associated with the hosted application to which the at least one customer-defined message handling rule is applicable to the customer to assist a customer in determining desired recipients of forwarded messages. The Examiner admits that Brown et al. does not disclose this feature and relies on element 48 of Escolar's Fig. 3 as allegedly disclosing this feature (Office Action, pg. 8). Appellants respectfully disagree with the Examiner's interpretation of Escolar.

Element 48 in Escolar's Fig. 3 corresponds to a list of contact numbers to call in response to an alarm (col. 3, lines 11-20). Escolar in no way discloses or suggests displaying list 48 to a

customer to assist the customer in determining desired recipients of forwarded messages, as recited in claim 20. In stark contrast, list 48 provides the order in which telephone calls are to be placed in response to an alarm.

For at least these additional reasons, Appellants submit that the rejection of claim 20 under 35 U.S.C. § 103(a) based on Brown et al. and Escolar is improper. Accordingly, Appellants request that the rejection be reversed.

D. The rejection under 35 U.S.C. § 103(a) based on Brown et al. (U.S. Patent No. 6,631,363) should be reversed.

1. Claim 17.

Claim 17 depends from claim 35. Therefore, claim 17 is not anticipated by Brown et al. for at least the reasons given above with respect to claim 35. Moreover, claim 17 recites additional features not disclosed or suggested by Brown et al.

Claim 17 recites displaying a list of available delivery methods for automatic forwarding of messages to a customer, and determining from the customer a desired delivery method for transmission of a message to a desired recipient, wherein at least one delivery method comprises transmission to a pager. The Examiner alleges that "Brown further discloses at least one delivery method comprises transmission to a pager email transmission" and points to col. 5, line 65, to col. 6, line 4, of Brown et al. for support (Office Action, pg. 6). Appellants respectfully disagree with the Examiner's interpretation of Brown et al.

At col. 5, line 65, to col. 6, line 4, Brown et al. discloses:

ally; this is done automatically by the rules set up in the alert manager. Users can determine how these messages are to be sent. E-mail would be one typical type of

message; users may also provide for one or more notification windows to be generated upon their desktop for the sole purpose of receiving alert notifications.

This section of Brown et al. discloses that users can have message delivered via e-mail. This section of Brown et al. in no way discloses or suggests displaying a list of available delivery methods for automatic forwarding of messages to a customer, and determining from the customer a desired delivery method for transmission of a message to a desired recipient, wherein at least one delivery method comprises transmission to a pager, as required by claim 17. In fact, this section of Brown et al. does not even mention transmission via a pager.

Further with respect to the above feature of claim 17, the Examiner admits that Brown et al. does not disclose displaying a list of available delivery methods for automatic forwarding of messages to a customer, and determining from the customer a desired delivery method for transmission of a message to a desired recipient, wherein at least one delivery method comprises transmission to a pager and alleges:

one of ordinary skill in the art would recognize the benefits of displaying a list of available delivery methods in order to determine as to how the system can notify the user. BY this rationale, "Official Notice" is taken that both the concept and advantages of providing for a list of available delivery methods is well known and expected in the art. It would have been obvious to one of ordinary skill in the art to modify the system of Brown to include an available delivery method list in order for the system to let the user know of the capabilities of the notification system, resulting in a concise user interface for which the user to define the notifications

(Office Action, pg. 6). Appellants respectfully disagree with the Examiner's allegations.

As set forth in M.P.E.P. § 2144.03, in limited circumstances, it may be appropriate for an Examiner to take Official Notice of facts not in record or to rely on "common knowledge" in making a rejection, however, such rejections should be judiciously applied. As further set forth in M.P.E.P. §2144.03, it is not appropriate for the Examiner to take Official Notice of facts

without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. Appellants respectfully submit that the features of "displaying a list of available delivery methods for automatic forwarding of messages to a customer, and determining from the customer a desired delivery method for transmission of a message to a desired recipient, wherein at least one delivery method comprises transmission to a pager" are not well-known in the art, and represents Appellants' solution to providing messages to a recipient. Appellants submit that the Examiner's conclusory allegation of obviousness with respect to the above-noted features, represents impermissible hindsight derived from Appellants' own disclosure, and not from the teachings of the prior art.

For at least these additional reasons, Appellants submit that the rejection of claim 17 under 35 U.S.C. § 103(a) based on Brown et al. is improper. Accordingly, Appellants request that the rejection be reversed.

4. Claim 18.

Claim 18 depends from claim 35. Therefore, claim 18 is not anticipated by Brown et al. for at least the reasons given above with respect to claim 35. Moreover, claim 18 recites additional features not disclosed or suggested by Brown et al.

Claim 18 recites displaying a list of available delivery methods for automatic forwarding of messages to a customer, and determining from the customer a desired delivery method for transmission of a message to a desired recipient, wherein at least one delivery method comprises e-mail transmission. The Examiner admits that Brown et al. does not disclose the above features of claim 18 and alleges:

one of ordinary skill in the art would recognize the benefits of displaying a list of available delivery methods in order to determine as to how the system can notify

the user. BY this rationale, "Official Notice" is taken that both the concept and advantages of providing for a list of available delivery methods is well known and expected in the art. It would have been obvious to one of ordinary skill in the art to modify the system of Brown to include an available delivery method list in order for the system to let the user know of the capabilities of the notification system, resulting in a concise user interface for which the user to define the notifications

(Office Action, pg. 6). Appellants respectfully disagree with the Examiner's allegations.

As set forth in M.P.E.P. § 2144.03, in limited circumstances, it may be appropriate for an Examiner to take Official Notice of facts not in record or to rely on "common knowledge" in making a rejection, however, such rejections should be judiciously applied. As further set forth in M.P.E.P. §2144.03, it is not appropriate for the Examiner to take Official Notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. Appellants respectfully submit that the features of "displaying a list of available delivery methods for automatic forwarding of messages to a customer, and determining from the customer a desired delivery method for transmission of a message to a desired recipient, wherein at least one delivery method comprises e-mail transmission" are not well-known in the art, and represents Appellants' solution to providing messages to a recipient. Appellants submit that the Examiner's conclusory allegation of obviousness with respect to the above-noted features, represents impermissible hindsight derived from Appellants' own disclosure, and not from the teachings of the prior art.

For at least these additional reasons, Appellants submit that the rejection of claim 18 under 35 U.S.C. § 102(e) based on Brown et al. is improper. Accordingly, Appellants request that the rejection be reversed.

5. Claim 19.

Claim 19 depends from claim 35. Therefore, claim 19 is not anticipated by Brown et al. for at least the reasons given above with respect to claim 35. Moreover, claim 19 recites additional features not disclosed or suggested by Brown et al.

Claim 19 recites displaying a list of available delivery methods for automatic forwarding of messages to a customer, and determining from the customer a desired delivery method for transmission of a message to a desired recipient, wherein at least one delivery method comprises transmission via an Internet post operation. The Examiner admits that Brown et al. does not disclose the above features of claim 19 and alleges:

one of ordinary skill in the art would recognize the benefits of displaying a list of available delivery methods in order to determine as to how the system can notify the user. BY this rationale, "Official Notice" is taken that both the concept and advantages of providing for a list of available delivery methods is well known and expected in the art. It would have been obvious to one of ordinary skill in the art to modify the system of Brown to include an available delivery method list in order for the system to let the user know of the capabilities of the notification system, resulting in a concise user interface for which the user to define the notifications

(Office Action, pg. 6). Appellants respectfully disagree with the Examiner's allegations.

As set forth in M.P.E.P. § 2144.03, in limited circumstances, it may be appropriate for an Examiner to take Official Notice of facts not in record or to rely on "common knowledge" in making a rejection, however, such rejections should be judiciously applied. As further set forth in M.P.E.P. §2144.03, it is not appropriate for the Examiner to take Official Notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. Appellants respectfully submit that the features of "displaying a list of available delivery methods for automatic forwarding of

messages to a customer, and determining from the customer a desired delivery method for transmission of a message to a desired recipient, wherein at least one delivery method comprises transmission via an Internet post operation" are not well-known in the art, and represents Appellants' solution to providing messages to a recipient. Appellants submit that the Examiner's conclusory allegation of obviousness with respect to the above-noted features, represents impermissible hindsight derived from Appellants' own disclosure, and not from the teachings of the prior art.

For at least these additional reasons, Appellants submit that the rejection of claim 19 under 35 U.S.C. § 102(e) based on Brown et al. is improper. Accordingly, Appellants request that the rejection be reversed.

VIII. CONCLUSION

In view of the foregoing arguments, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejections of claims 2-9, 14-20, 24-31, and 34-36 under 35 U.S.C. §§ 102 and 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 07-2347 and please credit any excess fees to such deposit account.

Respectfully submitted,

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IX. CLAIM APPENDIX

2. A network based automated message handling system according to claim 34, wherein said at least one customer-defined message handling rule directs notification of a third party software developer when a software fault is indicated by the contents of a message.

3. A network based automated message handling system according to claim 34, further comprising a customer-interface portal, said portal providing an interface for a customer to express customer-defined rules.

4. A network based automated message handling system according to claim 3, wherein said portal interface for allowing a customer to define customer-defined rules allows a customer to express rules identifying messages for which the contents of the message should be automatically forwarded to at least one desired recipient.

5. A network-based automated message handling system according to claim 4, wherein said portal interface allows a customer to identify a delivery method for messages to be automatically forwarded to said at least one desired recipient from a list of available delivery methods, wherein at least one of the available delivery methods is a pager notification method.

6. A network-based automated message handling system according to claim 4, wherein said portal interface allows a customer to identify a delivery method for messages to be automatically forwarded to said at least one desired recipient from a list of available delivery

methods, wherein at least one of the available delivery methods is an e-mail notification.

7. A network-based automated message handling system according to claim 4, wherein said portal interface allows a customer to identify a delivery method for messages to be automatically forwarded to said at least one desired recipient from a list of available delivery methods, wherein at least one of the available delivery methods is a message posted to an internet address.

8. A network-based automated message handling system according to claim 4, wherein said portal interface allows a customer to express without prompting at least one desired recipient.

9. A network-based automated message handling system according to claim 4, further comprising a contacts list tool, said contacts list tool identifying entities associated with a hosted application, wherein said portal interface further identifies entities associated with a hosted application by reference to the contacts list tool, and presents the entities associated with a hosted application to a customer as potential recipients of an automatically forwarded message.

14. A process for automated dissemination of application components information according to claim 35, further comprising:

transmitting at least one of the generated messages via a pager system.

15. A process for automated dissemination of application component information according to claim 35, further comprising:

transmitting at least one of the generated messages via an Internet post operation.

16. A process for automated dissemination of application component information according to claim 35, wherein the at least one customer-defined message handling rule directs notification of a third party software developer when a software fault is indicated by the contents of an information message.

17. A process for automated dissemination of application component information according to claim 35, further comprising:

displaying a list of available delivery methods for automatic forwarding of messages to a customer, and determining from the customer a desired delivery method for transmission of a message to a desired recipient, wherein at least one delivery method comprises transmission to a pager.

18. A process for automated dissemination of application component information according to claim 35, further comprising:

displaying a list of available delivery methods for automatic forwarding of messages to a customer, and determining from the customer a desired delivery method for transmission of a message to a desired recipient, wherein at least one delivery method comprises e-mail transmission.

19. A process for automated dissemination of application component information according to claim 35, further comprising:

displaying a list of available delivery methods for automatic forwarding of messages to a customer, and determining from the customer a desired delivery method for transmission of a message to a desired recipient, wherein at least one delivery method comprises transmission via an Internet post operation.

20. A process for automated dissemination of application component information according to claim 35, further comprising:

determining a list of entities associated with a hosted application to which the at least one customer-defined message handling rule is applicable by reference to a contacts list tool and displaying the list of entities associated with the hosted application to which the at least one customer-defined message handling rule is applicable to the customer to assist a customer in determining desired recipients of forwarded messages.

24. A computer-readable medium tangibly embodying instructions according to claim 36, wherein said at least one customer-defined message handling rule further comprises an action forwarding a received message to at least one further recipient.

25. A computer-readable medium tangibly embodying instructions according to claim 24, wherein said action forwarding a received message further defines a transmission method for

forwarding said message to said at least one further recipient.

26. A computer-readable medium tangibly embodying instructions according to claim 25, wherein said transmission method causes said message to be forwarded to said at least one further recipient via a pager system.

27. A computer-readable medium tangibly embodying instructions according to claim 25, wherein said transmission method causes said message to be forwarded to said at least one further recipient via e-mail.

28. A computer-readable medium tangibly embodying instructions according to claim 25, wherein said transmission method causes said message to be forwarded to said at least one further recipient via an Internet post.

29. A computer-readable medium tangibly embodying instructions according to claim 25, wherein the message identifies a software fault.

30. A computer-readable medium tangibly embodying instructions according to claim 29, wherein the message handler is configured to:

identify at least one further recipient to whom a software fault message should automatically be forwarded.

31. A computer-readable medium tangibly embodying instructions according to claim 30, wherein the message handler is further configured to:

determine a list of potential recipients to whom a software fault message may be automatically forwarded by reference to data stored in a contacts list management tool, and cause the determined list to be displayed to a customer to assist the customer in identifying recipients to whom a software fault message should automatically be forwarded.

34. A network-based automated message handling system for initiating responses to messages transmitted through a network by application components, the system comprising:

at least one customer-defined message handling rule;

at least one service-based message handling rule;

at least one common message handling rule; and

a message handler configured to:

receive a message from an application component,

determine, based on a content of the received message, whether to apply the at least one customer-defined message handling rule,

determine, based on the content of the received message, whether to apply the at least one service-based message handling rule,

determine, based on the content of the received message, whether to apply the at least one common message handling rule,

identify at least one first party when the at least one customer-defined message handling rule applies to the received message,

identify at least one second party when the at least one service-based message handling rule applies to the received message,

identify at least one third party when the at least one common message handling rule applies to the received message, and

generate new messages to the identified at least one first party, the identified at least one second party, and the identified at least one third party.

35. A process for automated dissemination of application component information, the process comprising:

receiving an information message from an application component;

determining, based on a content of the information message, whether to apply at least one customer-defined message handling rule to the received information message;

determining, based on the content of the information message, whether to apply at least one service-based message handling rule to the received information message;

determining, based on the content of the information message, whether to apply at least one common message handling rule to the received information message;

identifying a first group of parties when the at least one customer-defined message handling rule applies to the received information message;

identifying a second group of parties when the at least one service-based message handling rule applies to the received information message;

identifying a third group of parties when the at least one common message handling rule applies to the received information message; and

generating new messages to the identified first group of parties, the identified second group of parties, and the identified third group of parties.

36. A computer-readable medium tangibly embodying instructions which, when executed by a computer, implement a process for automating message handling, the instructions causing a message handler to:

receive a message;

determine, based on a content of the message, whether to apply at least one customer-defined message handling rule, at least one service-based message handling rule, or at least one common message handling rule to the received message;

identify a first group of parties when the at least one customer-defined message handling rule applies to the received message;

identify a second group of parties when the at least one service-based message handling rule applies to the received message;

identify a third group of parties when the at least one common message handling rule applies to the received message; and

generate new messages to the identified first group of parties, the identified second group of parties, and the identified third group of parties.

X. EVIDENCE APPENDIX

None.

XI. RELATED PROCEEDINGS APPENDIX

None.